

REMARKS

Claims 1-43 are pending in the present application. Claims 13-43 have been withdrawn from consideration by the Office. Claims 1-12 have been rejected and are amended as indicated above.

Restriction Requirement

The Office has withdrawn claims 13-43 from further consideration as being drawn to a nonelected invention and/or species. In paragraph 2 of the Office Action, the Office notes that there is no allowable generic or linking claim.

Applicant respectfully disagrees that there is no generic claim. As noted in Applicant's election of November 7, 2003, claims 1, 4, 5, 6, 7, and 8 are generic to all three of species a, b and c, and each of the subspecies defined under species a and b. Applicant also noted that claims 2, 3, & 9-12 are similarly generic to more than the elected specie and subspecie.

Rejection under 35 U.S.C. §102(e) Over Krivy et al.

Claims 1-5, 8, and 12 have been rejected under 35 U.S.C. §102(e) as being anticipated by Krivy et al. (U.S. Patent 6,239,590) for the reasons noted on pages 2-3 of the Office Action. Applicant respectfully traverses this rejection.

As to claims 1-5, the Office argues that Krivy et al. anticipate the pending claims by disclosing an alignment mark (any one of the probe contacts labeled 40) in Figure 9. Applicant respectfully disagrees with the Office's interpretation of this reference. Throughout the

reference, Krivy et al. repeatedly refer to component 40 as a probe contact and not as an alignment mark.

Further, the device illustrated in Figure 9 is a test system 38a that is used in combination with calibration target 10. *See columns 9-10.* The calibration target 10 contains a substrate 12 with a plurality of alignment features 14A, 14B, 14C and 14D and 14E. *See column 4, lines 25-35.* Knowing that calibration target 10 contained the alignment features, the skilled artisan would have understood that probe contact 40 was indeed just a probe contact, and not an alignment feature. And the Office has pointed to no disclosure in Krivy et al. that would lead the skilled artisan to believe that the probe contacts 40 would be anything other than what they are explicitly described as.

As to claims 8 and 12, the Office contends that Krivy et al. describe a plurality of alignment marks (18) disposed on the contactor substantially below the plane wherein the distal tips of the contact tips (32) are disposed. A simple analysis of Figure 10D illustrates the error of the Office's allegation. In that Figure, it appears that the component 18 and component 32 are nearly co-planar. Indeed, based on the description of how components 18 and 32 are formed, the skilled artisan would have understood that component 18 was not substantially below the plane of the distal tips of the contact tips 32. *See column 11.*

Accordingly, the Office has not shown that Krivy et al. teach each and every limitation of the rejected claims. Accordingly, Applicant respectfully requests withdrawal of this ground of rejection.

Rejection Under 35 U.S.C. §102(b) Over Hajime

Claims 1-3, 5, 6, and 8-11 have been rejected under 35 U.S.C. §102(b) as being clearly anticipated by Hajime (JP10160793). Applicant respectfully traverses this rejection.

As noted in MPEP §2131, the burden is upon the Office to show that the cited prior art discloses each and every element of the pending claims. Conspicuously absent in the rejection on page 4 of the Office Action, however, is any explanation as to how (or where) Hajime teaches each and every limitation in the rejected claims.

Despite the Office's failure, Applicant notes that the device disclosed in Hajime contains an alignment mark 8 on the substrate 1. Substrate 1 also contains protrusion 7 which is brought into contact with an aluminum pad of a bare chip to be inspected. The alignment mark, however, is located on the substrate 1 on which the chip resides, not on the element that is contacted for the inspection, i.e., protrusion 7. *See Abstract.*

Thus, the Office has not shown where Hajime discloses each and every limitation of the rejected claims. Accordingly, Applicant respectfully requests withdrawal of this ground of rejection.

Rejection Under 35 U.S.C. §102(b) Over Masao

Claim 1 has been rejected under 35 U.S.C. §102(b) as being clearly anticipated by Masao (JP06209033). Applicant respectfully traverses this rejection.

As noted above, the burden is upon the Office to show that Masao discloses each and every limitation of the pending claims. Again, the Office has not met this burden.

Despite the Office's failure, Applicants notes that Masao does not teach—as recited in Claim 1—a pad on which the contact tip is disposed. The alignment marks 1 and 2 of Masao,

however, are not on the pad. Rather, the alignment marks 1 and 2 are on the rod section of the contact element.

Thus, the Office has not shown where Masao discloses each and every limitation of the rejected claims. Accordingly, Applicant requests withdrawal of this ground of rejection.

Rejection Under 35 U.S.C. §102(e) over Akram et al.

Claim 1 has been rejected under 35 U.S.C. §102(e) as being clearly anticipated by Akram et al. (U.S. Patent 6,285,203). Applicant respectfully traverses this rejection.

Once again, the Office has failed to substantiate that Akram et al. teach each and every limitation recited in the rejected claim. The Office does, however, summarily cite to Figure 10C. Yet the Office does not argue or allege where Figure 10C of Akram et al. discloses each and every limitation recited in the rejected claim.

Despite the Office's failure, Applicant notes that claim 1 requires a contact tip disposed on a surface of a pad. The Office has not shown that Figure 10C of Akram et al. discloses a contact tip disposed on a pad.

Thus, the Office has not shown that Akram et al. disclose each and every limitation of claim 1. Accordingly, Applicant respectfully requests withdrawal of this ground of rejection.

Rejection Under 35 U.S.C. §102(e) Over Akram et al.

Claim 6-7 have been rejected under 35 U.S.C. §102(e) as being anticipated by Akram et al., for the reasons noted on page 4-5 of the Office Action. Applicant respectfully traverses this rejection.

Independent claim 6 currently recites that a plurality of contact structures are disposed above the upper surface of a substrate. The Office has cited Figures 10A through 10C and Figure 13B as anticipating the rejected claims.

Applicant respectfully disagrees that the Office has substantiated that these figures of Akram et al. disclose each and every limitation in claim 6. As best seen in Figures 10B, 10C and 13A, the contact structures 26 in these devices of Akram et al. are disposed below the upper surface of substrate on which the contact structure is formed. Thus, the Office has not shown where Akram et al. teaches each and every limitation recited in claim 6.

Accordingly, the Office has not substantiated its burden of showing anticipation and Applicant respectfully requests withdrawal of this ground of rejection.

Rejection Under 35 U.S.C. §102(e) Over Krivy et al.

Claim 6 has been rejected under 35 U.S.C. §102(e) as being clearly anticipated by Krivy et al. Applicant again respectfully traverses this rejection.

Once more, the Office has failed to meet its burden of showing that Krivy et al. teach each and every limitation recited in current claim 6. While it summarily notes Figure 9 in the rejection, the Office provides no explanation of why the device in this Figure discloses each and every limitation in current claim 6.

Despite the Office's failure to meet this burden, Applicant notes that claim 6 recites a contactor containing a plurality of contact structures and means for aligning the plurality of contact structures. As noted above, the skilled artisan would have understood that the holding mechanism 114 of Krivy et al. (which contains probe card 42 with contact probes 40) would not

have contained the alignment marks since calibration device 10 contained such alignment features.

Thus, the Office has not shown that Krivy et al. disclose each every limitation of the rejected claim. Accordingly, Applicant requests withdrawal of this ground of rejection.

Rejection Under 35 U.S.C. 103

Claims 9-11 have been rejected under 35 U.S.C. §103 as being unpatentable over Krivy et al. in view of Akram et al. Applicant respectfully traverses this rejection.

As noted above, the Office has not shown that Krivy et al. disclose the claimed invention. Specifically, the Office has not substantiated that Krivy et al. describe a contactor containing both a plurality of contacts and a plurality of alignment marks. Rather, as noted above, Krivy et al. describe that calibration target 10 (and not probe card 42) contains a plurality of alignment features 14A, 14B, 14C and 14D and 14E.

The Office has not argued or even alleged that Akram et al. would teach the skilled artisan to move the alignment marks 14A, 14B, 14C and 14D and 14E from the calibration target 10 to the probe card 42 in the device in Figure 9. Without such a showing, the Office cannot substantiate that the combination of the prior art suggests each and every limitation in the pending claims.

Thus, the Office has not shown that the combination of the cited art suggests each and every limitation of the rejected claim. Accordingly, Applicant requests withdrawal of this ground of rejection.

CONCLUSION

For the above reasons, Applicant respectfully requests the Office to withdraw the above grounds of rejection and allow the pending claims.

If there is any fee due in connection with the filing of this Amendment, including a fee for any extension of time not accounted for above, please charge the fee to our Deposit Account No. 18-0013.

Respectfully Submitted,

By 
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